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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/390,846 09/14/99 KOK

J I/95150-US/D

EXAMINER

HM12/1023

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FIELDS, I

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

10/23/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/390,846

Applicant(s)

KOK ET AL.

Examiner

Iesha P Fields

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 13, 16-20, and 23-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Applicant's amendment received August 9, 2001 (Paper No. 8) has been received and entered. Claim 16 was amended consequently claims 1-3, 11, 13, 15-20, and 23-24 are pending in the instant application.

Election/Restrictions

Claims 1-15 were previously subjected to a restriction requirement, as set forth in the Office Action (Paper No. 3) mailed September 5, 2000. Applicant's elected with traverse Group I claims 1-3 on October 2, 2000 (Paper No. 4). The Examiner found the Applicant's traversal persuasive for the recombining of Groups I (claims 1-3) and Group II (claims 11, 13). However, Claim 15, drawn to a method was not rejoined, only the vaccine claims with the protein claims. In addition, claims 16-20 and 23-24 filed in Applicant's Amendment on February 21, 2001 (Paper No. 6) were examined in the Office Action (Paper No. 7). As stated previously, claims 21-22 and 25 are directed to an invention that is independent or distinct from the invention originally claimed. Therefore the claims were not examined previously for reasons disclosed in the Office Action and will not be examined in this Office Action.

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 102

1. Claims 1-3 and 11, 13, 16-20 and 23-24 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Binger et al. is **maintained**.

Applicant's have asserted that the specification describes an isolated "intracellular" *Eimeria* protein. Applicant's have further asserted that Binger et al. discloses surface antigens of *Eimeria* and thus does not anticipate the claimed invention.

Applicant's arguments have been carefully considered but not deemed persuasive.

The claims are drawn to an *Eimeria* protein wherein the protein has a molecular weight of about 37 kD.

As stated previously, Binger et al. disclose several immunogenic *Eimeria* proteins including an *Eimeria* schizont protein which has a molecular weight of about 37 kilodaltons. Binger et al. further disclose that the *Eimeria* antigen is present in the sporozoite, merozoite, and the schizont developmental stages of the parasite. Binger et al. further disclose that the proteins may be used to make a vaccine preparation.

Regarding the argument that the specification describes an isolated intracellular *Eimeria* protein. 1) The claims do not recite this limitation 2) Binger et al. clearly state in Section 6.1.9 of the specification that the 37 kD protein of *Eimeria* is synthesized throughout the "intracellular" development of the parasite. The prior art therefore anticipates the claimed invention.

Status of Claims

2. All claims stand rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

For the above reasons, it is believed that the rejections should be sustained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iesha P Fields whose telephone number is (703) 605-1208. The examiner can normally be reached on 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Iesha Fields

October 17, 2001


MARK NAVARRO
PRIMARY EXAMINER